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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,323	08/20/2001	Matthew J. Poduska	01P1511	3970

24234 7590 05/03/2005

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EXAMINER
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DANG, KHANH

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/682,323		PODUSKA, MATTHEW J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Khanh Dang		2111	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/14/2005 Appeal Brief.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

**In prepare for an Examiner's Answer in response to Applicant's Appeal Brief, a new issue regarding "enablement" defined in the 35 USC 112, 1<sup>st</sup> paragraph has been discovered and must be addressed before this application can be forwarded to the Board of Appeals.**

#### ***Claim Rejections - 35 USC § 112***

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter defined by the language "to be free from any direct connection with any inter-card bus" (claims 1 and 11) was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, page 5, discloses that "[t]he entire communication with first industry standard expansion card having an independent dedicated server function 124 is over first dedicated communication connector 134 or non-system bus connection dedicated to communicating with another card in PC housing 102."

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 6, 7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Asano et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

With regard to claim 1, Asano et al. discloses a computer system comprising: a chassis having a plurality of slots thereon each configured for receiving one of a plurality of planar shaped circuit cards therein (as for any server, it is inherent that a chassis (motherboard) must be provided to house a plurality of PCI slots for a plurality of planar PCI cards in full compliance with PCI Protocol, see at least Fig. 1, elements 7a, 7b, for example); a shroud coupled to the chassis to form an enclosure about the plurality of

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planar shaped circuit cards (as for any server, it is inherent that an enclosure must be provided to house the motherboard/chassis and components such as network cards) ; the plurality of planar shaped circuit cards (7a/7b, for example) each configured for providing an independent dedicated server function (each card 7a/b has its own processor and function independently, see at least column 1, line 64 to column 2, line 1; column 2, lines 37-45); and, each of the plurality of planar shaped circuit cards (7a, b for example) being configured so as to be free from any direct communication connection with any inter-card bus inside the enclosure (it is clear from at least Fig. 1 and description thereof that network cards 7a,b have no direct connection with the system bus).

With regard to claim 3, it is clear from at least Fig. 1 of Asano et al. that the PCI cards of Asano et al. must be in full compliance with PCI protocol. The PCI standard requires each PCI card receives either 3.3 or 5 Volts power from the motherboard. When a PCI card is inserted into a PCI slot, the PCI card's keys designed for either 3.3 or 5V fits into the slot to receive either 3.3 or 5 Volts from a single source (the motherboard) depending on the card's keys.

With regard to claims 4 and 6, as mentioned above, the PCI cards must be in full compliance with the PCI protocol.

With regard to claim 7, since PCI network cards, each having its own local processor and memory, have no direct connection to and function independently from the system bus, it is clear from Asano et al. that only those PCI traces are used for power supply.

With regard to claim 11, it is clear that one practicing the device of Asano et al. (see discussion above) would have performed the same steps set forth in claim 11. Note that every network card has an external connector for enabling connection to a network environment.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al.

Asano et al., as explained above, discloses the claimed invention including the use of a plurality of independently functioned PCI network cards. However, Asano et al. does not specifically disclose that the independent functions include "email server function," "web server function," and "file storage function." It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide such intended functions to the plurality of PCI network cards of Asano et al. by, for example, suitable software, since the Examiner takes Official Notice that "email server function," "web server function," and "file storage function" are all old and well-known for their

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applications in a network environment, and merely providing such functions to the independently functioned PCI network cards only involves ordinary skill in the art. If Applicant chooses to properly challenge the Official Notice, supportive document(s) will be provided upon request.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al.

Asano et al., as explained above, discloses the claimed invention except for the use of ISA slots instead of PCI slots. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use ISA protocol instead of or in addition to the PCI protocol as used in Asano et al., since the Examiner takes Official Notice that both PCI and ISA protocols are old and well-known in the art, and a selection of one over the other or both only involves ordinary skill in the art. If Applicant chooses to properly challenge the Official Notice, supportive document(s) will be provided upon request.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano et al.

Asano et al., as explained above, discloses the claimed invention including the use of a plurality of independently functioned PCI network cards. However, Asano et al. does not specifically disclose that the independent functions include "email server function," "web server function," and "file storage function." It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to provide such intended functions to the plurality of PCI network cards of Asano et al. by, for example, suitable software, since the Examiner takes Official Notice that "email server function," "web server function," and "file storage function" are all old and well-known for their applications in a network environment, and merely providing such functions to the independently functioned PCI network cards only involves ordinary skill in the art. If Applicant chooses to properly challenge the Official Notice, supportive document(s) will be provided upon request. With regard to claim 9, see discussion regarding to claim 3 above. With regard to claim 10, see discussion regarding to claim 6 above.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 571-272-3626.



Khanh Dang  
Primary Examiner